

REMARKS

In the Office Action, the Examiner rejected claims 6, and 9-13 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, and rejected claims 6, and 9-13 under 35 U.S.C. §102(e) as being anticipated by Norris (WO 01/65441). Applicants respectfully traverse each and every rejection included in the Office Action.

By this amendment, Applicants have amended claims 6, 9-10, and 13 of the application. Claims 6 and 9-13 remain pending. Applicants respectfully submit that the pending claims are in condition for allowance and request reconsideration and reexamination of this application.

Amendments to the Claims

Claims 6, 9-10, and 13 have been amended to enhance readability. Applicant has removed the phrase "it is difficult to estimate" from the claims. In addition, claims 6, 9-10, and 13 have been amended to specify that the main ingredient information related to "medical products" and that the second ingredient has "a different pharmacological effect" than the confidential first main ingredient. These amendments find support, for example, at page 29 of the specification, which describes the selection of acetaminophen, an antifeberile, as a stand-in for verapamil hydrochloride, a vasoconstrictor, when ordering a prototype.

Claim 6, as amended, recites "information conversion means" for "converting the main ingredient information to be transmitted to a computer system of a composition manufacturer from information regarding the confidential first main ingredient included in

a request from a product manufacturer to information regarding the second main ingredient stored in the database by selecting a second main ingredient.” The specification supports this amendment, for example, at pages 28 to 30.

Claim 9 has been amended to recite “information conversion software that converts main ingredient information to be transmitted to a computer system of a composition manufacturer from information regarding the confidential first main ingredient included in a request from the product manufacturer to information regarding the second main ingredient stored in the database by selecting a second main ingredient.” Pages 28 to 30 of the specification provide exemplary support for this amendment.

Claim 10 now requires “using the database to convert the main ingredient information to be transmitted to a computer system of a composition manufacturer from information regarding the confidential first main ingredient included in the request from the product manufacturer to information regarding a second main ingredient stored in the database by selecting a second main ingredient.” This amendment finds support, for example, at pages 28 to 30 of the specification.

Amended claim 13 recites “information conversion means using at least one of the computer processors for converting the main ingredient information to be transmitted to a computer system of a composition manufacturer from information regarding the confidential first main ingredient included in a request from the product manufacturer to information regarding the second main ingredient stored in the database by selecting a second main ingredient.” Pages 28 to 30 of the specification, for example, support this amendment to claim 13.

The Claims Meet the Requirements of 35 U.S.C. §112, Second Paragraph

The Office Action rejected all pending claims for reciting the phrase “it is difficult to estimate.” The claims, as amended, no longer contain this phrase. Applicant submits that, as amended, the claims meet the requirements of 35 U.S.C. § 112, second paragraph.

The Claims Are Allowable Over Norris

A. Norris Does Not Teach or Suggest the Claimed “Information Conversion Means” or “Information Conversion Software”

As amended, claims 6 and 13 recite “information conversion means ... for converting main ingredient information to be transmitted to a computer system of a composition manufacturer from information regarding the confidential first main ingredient included in a request from a product manufacturer to information regarding the second main ingredient stored in the database by selecting a second main ingredient.” Norris does not teach or suggest the claimed information conversion means for **converting** from “information regarding the confidential first main ingredient” included in a request from a product manufacturer to information “regarding the second main ingredient” stored in the database.

Instead of converting from a first main ingredient to a second main ingredient to be transmitted to a computer systems of a composition manufacturer, Norris teaches a “system and method for the automated selection of formulations ... by specifying product characteristics.” (Norris, Abstract.) This system includes a database 70, including information regarding formulations for selection by customers. (See, for example, *Id.* at 13, lines 5-14.) Norris neither teaches nor suggests information

conversion means for converting from information regarding a confidential first main ingredient to information regarding the second main ingredient by selecting a second main ingredient. Instead, Norris presents all formulations meeting customer-defined criteria to that customer. Moreover, nothing in Norris suggests “converting main ingredient information to be transmitted to a computer system of a composition manufacturer from information regarding the confidential first main ingredient included in a request from a product manufacturer,” as amended claims 6 and 13 require. For at least these reasons, claims 6 and 13 are allowable over Norris.

As amended, claim 9 requires “information conversion software that converts main ingredient information to be transmitted to a computer system of a composition manufacturer from information regarding the confidential first main ingredient included in a request from the product manufacturer to information regarding the second main ingredient stored in the database by selecting a second main ingredient.” Nothing in Norris teaches or suggests software that converts main ingredient information to be transmitted to a composition manufacturer, let alone software for converting confidential first main ingredient information into second main ingredient information. For at least these reasons, claim 9 is allowable over Norris.

Claim 10, as amended, recites the step of “using the database to convert the main ingredient information to be transmitted to a computer system of a composition manufacturer from information regarding the confidential first main ingredient included in the request from the product manufacturer to information regarding a second main ingredient stored in the database by selecting a second main ingredient.” The methods for selecting formulations in Norris neither teach nor suggest using a database in this

manner. For at least this reason claim 10 is allowable over Norris. Claims 11-12 are allowable at least due to their dependence from claim 10.

B. Norris Does Not Teach or Suggest Selecting a Second Main Ingredient Having a Different Pharmacological Effect than the First Main Ingredient

As amended, claims 6, 9-10, and 13 require the selection of a second ingredient having “a different pharmacological effect” than the confidential first main ingredient. Norris does not disclose—and teaches away from—at least this feature of the claims.

Nothing in Norris suggests selecting a second ingredient having a “different pharmacological effect” than a first ingredient. Norris describes a “system and method for the automated selection of formulations ... by specifying product characteristics” (Norris, Abstract.) The system taught by Norris allows a customer to “provide performance criteria to locate formulations that most appropriately meet their needs from a variety of suppliers.” (*Id.* at 7, lines 10-22.) The system in Norris matches potential formulations **to match these customer-defined performance criteria**. To the extent that the system of Norris could be used to develop pharmaceuticals, all formulations presented to the customer would have the same pharmacological effect.

Figure 8 of Norris provides a “flow diagram of the process of a customer stepping through the Formulation Web Site to derive a set of formulations.” (*Id.* at 16, lines 1-2.) Specifically, “the customer enters information that defines the formulation application, e.g. coatings, glue, clock circuits, etc.” and “enters limits and prioritizes features in selecting the formulation.” (*Id.* at 16, lines 3-5.) A set of requirements is defined and used to generate a query. (*Id.* at 16, lines 5-7.) The results of this query are output, allowing the customer to “view the results,” compare formulations, and “select desired ones of the formulations to save for later, purchase components, and etc.” (*Id.* at 16,

lines 7-11.) Again, through Figure 8's flow diagram, Norris suggests selecting several formulations intended to meet **the same application**, not different pharmacological effects.

Moreover, Figure 16 of Norris "presents an example web page output," illustrating a side-by-side comparison presented to a customer by the system described in Norris. (Norris, 17:29-30.) Reviewing this figure shows that all the selected formulations are odorless spray metal solvents for external industrial use. (Norris, Fig. 16.) Indeed, page 20 of Norris indicates that "[e]ach formulation may have slightly different characteristics but each was selected by the system as meeting the customers stated performance specifications." (Norris, 20:3-4) Thus, for at least these reasons, Norris neither teaches nor suggests selecting a second ingredient having a "different pharmacological effect" than a first ingredient, as recited in amended claims 6, 9-10, and 13. Claims 11-12 are allowable at least due to their dependence from claim 10.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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